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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/091,784	03/06/2002	Wayne M. Barnes	60019630-0038	9712

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EXAMINER	
CHUNDURU, SURYAPRABHA	
ART UNIT	**PAPER NUMBER**
1637	

DATE MAILED: 02/14/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Advisory Action Before the Filing of an Appeal Brief	**Application No.** 10/091,784	**Applicant(s)** BARNES ET AL.	
	Examiner Suryaprabha Chunduru	**Art Unit** 1637	

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 23 January 2006 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:
   a) ☒ The period for reply expires _____months from the mailing date of the final rejection.
   b) ☒ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

   Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. ☒ The Notice of Appeal was filed on *23 January 2006*. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. ☐ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
   (a) ☐ They raise new issues that would require further consideration and/or search (see NOTE below);
   (b) ☐ They raise the issue of new matter (see NOTE below);
   (c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
   (d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

   NOTE: _____. (See 37 CFR 1.116 and 41.33(a)).
4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).
5. ☐ Applicant's reply has overcome the following rejection(s): _____.
6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
7. ☒ For purposes of appeal, the proposed amendment(s): a) ☐ will not be entered, or b) ☒ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.
   The status of the claim(s) is (or will be) as follows:
   Claim(s) allowed: *none*.
   Claim(s) objected to: *none*.
   Claim(s) rejected: *1-7*.
   Claim(s) withdrawn from consideration: *8-13*.

AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing a good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because: See Continuation Sheet.
12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08 or PTO-1449) Paper No(s). _____
13. ☐ Other: _____.

Prabha Chunduru 2/8/06
SURYAPRABHA CHUNDURU
PATENT EXAMINER

Continuation of 11. does NOT place the application in condition for allowance because: Applicants' arguments are found unpersuasive.With regard to the rejection under 35 USC102 (b) as being anticipated by Lin et al. Applicants' arguments are fully considered and found unpersuasive. Applicants argue that Lin et al. does not teach MgHPO4 in col. 7, line 44-49 as suggested by the examiner and did not teach a source of phosphate ions and a source of magnesium ions form a precipitate at a temperature below 34 C and argue that the solution taught by Lin et al. is used for lypolization purposes rather than for use as a precipitate and thus Lin et al. teaches away from the instant invention. Applicants' arguments are fully considered and found unpersuasive. First, Examiner clearly mentioned that the "wherein" clause and the limitations followed by wherein clause are inherent property of a kit ,that comprises a source of phosphate and a source of magnesium ions. Thus the arguments based on wherein clause, forming a precipitate at a temperature below 34 C are unpersuasive because the kit taught by Lin et al. does comprise a source of phosphate ions (Na2HPO4) and a source of magnesium ions (MgCl2). As noted in MPEP 2112.01 "Products of identical chemical composition can not have mutually exclusive properties."A chemical composition and its properties are inseparable. Therefore, if the prior art teaches the identical chemical structure, the properties applicant discloses and/or claims are necessarily present. In re Spada, 911 F.2d 705, 709, 15 USPQ2d 1655, 1658(Fed. Cir. 1990). It is also noted that according to the MPEP 2112.02 -The discovery of a new use for an old structure based on unknown properties of the structure might be patentable to the discoverer as a process of using. In re Hack, 245 F.2d 246, 248, 114 USPQ 161, 163 (CCPA 1957). However, when the claim recites using an old composition or structure and the "use" is directed to a result or property of that composition or structure, then the claim is anticipated. In re May, 574 F.2d 1082, 1090, 197 USPQ 601, 607 (CCPA 1978). Thus the use of old composition to show new property have no patentable value. Thus the phrase "wherein combining the source of magnesium ions and the source of phosphate ions in accordance with the instructions supplied in the kit forms a precipitate at a temperature below 34 C" is an inherent property of the kit comprising a source of magnesium ions and a source of phosphate ions and instructions for use of the kit. Further, instructions for using the source of phosphate and magnesium ions , is drawn to an intened use which is not given any patentable weiight.because a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. In a claim drawn to a process of making, the intended use must result in a manipulative difference as compared to the prior art. See In re Casey, 152 USPQ 235 (CCPA 1967) and In re Otto, 136 USPQ 458, 459 (CCPA 1963). Applicants' assertions regarding MgHPO4 is incorrect because Examiner did not discuss such component in the rejection. With regard to the assertions on Lin et al. teaches away from the instant invention, Examiner notes that according to MPEP 2145, "A prior art reference that "teaches away" from the claimed invention is a significant factor to be considered in determining obviousness; however, "the nature of the teaching is highly relevant and must be weighed in substance. A known or obvious composition does not become patentable simply because it has been described as somewhat inferior to some other product for the same use." In re Gurley, 27 F.3d 551, 554, 31 USPQ2d 1130, 1132 (Fed. Cir. 1994), a teaching away, is a significant factor to be considered as "teaching in". , Examiner notes that the solution taught by Lin et al. is not for the purpose of lypolization because in col. 7, line 44-49, Lin et al. teach that the kit components can be packed either as a lipolized form or in a solution form. Therefore the rejection is maintained herein.

With regard to the rejection under 35 USC 103(a) as being unpatentable over Bloch et al. in view of Stanley, Applicants' arguments are fully considered and found unpersuasive. Applicants argue that the combination of Bloch et al. in view of Stanely did not suggest or teach the instant claims because Stanely did not teach magnesium as a suitable lypotropic salts, i.e., a salt which has the property of promoting precipitation (salting out)and argues that Stanely teaches away from the use of magensium by reciting only monovalently charged cations and does not teach lypotropic salts precipitate at temperatures below 34 C as required by claim 1. Applicants' arguments are fully considered and found unpersuasive.The rejection under 35 USC 103(a) is based on alternatively taking the limitations followed by "wherein clause" into consideration. Stanely taught some suitable lypotropic salts., and it does not mean that other salts having lypotropic property are eliminated from the list mentioned by Stanley. Further Stanely et al. does teach salting-out at temperature below 34 C as discussed in the rejection. With regard to Applicants' assertions that there is no suggestion or teaching to combine the references, examiner notes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See In re Fine, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and In re Jones, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir.1992). In the instant context, as discused in the rejection, Bloch et al. teach Kit composition including source of magnesium and silent regarding the source of phosphate ions and Stanely teaches phosphoric acid as a source of phosphate ions and provides motivation to use phosphoric acid as a donor of phosphate ions. Thus as discussed in the rejection one skilled in the art would be motivated to combine the kit as disclosed by Bloch et al. in a manner taught by Stanley because Stanley explicitly taught the use of a source of phosphate ions, and use of such ions in promoting precipitation (salting-out) of certain types of high molecular weight species (at temperatures ranging from 20-25 C), such as proteins in the aqueous solution and thereby enhancing the attachment of molecular species (oligonucleotides) to the water-soluble intermediate reagent (nucleic acid target) (see col. 7, line 18-43).

With regard to the Applicants' assertion drawn to the Stanely reference teaching away from the instant invention as discussed above MPEP 2145 states, "A prior art reference that "teaches away" from the claimed invention is a significant factor to be considered in determining obviousness; however, "the nature of the teaching is highly relevant and must be weighed in substance. A known or obvious composition does not become patentable simply because it has been described as somewhat inferior to some other product for the same use." In re Gurley, 27 F.3d 551, 554, 31 USPQ2d 1130, 1132 (Fed. Cir. 1994), a teaching away, is a significant factor to be considered as "teaching in". In the instant context the teachings of Stanely are based on the use of a source of phosphate ions and Bloch reference teach all the limitations including a source of magnesium and it is obvious that the combination of phosphate ions to the kit components comprising a source of magnesium would result in a precipitate (slting out) as discussed in the rejection. Therfore the rejection is maintained herein.

With regard to the rejection under 35 USC 103(a) as being unpatentable over Bloch et al. in view of Stanely further in view of Barnes et al., Applicants' arguments are fully considered and found unpersuasive.Applicants argue that the combination of Bloch in view of Stanley does not render the instant claim 1 obvious and the combination further in view of Barnes does not make the instant

claims (dependent on claim 1) obvious. As discussed above , the combiantion of Bloch et al. in view of Stanely does make the claim 1 obvious and the combination of Bloch et al. in view of Stanely further in view of Barnes does make the instant claims obvious for the use of thermostable DNA polymerase as taught by Barnes et al. Therefore the rejection is maintained herein.